

REMARKS

Claims 1-3, 5, 7-12, 21, 22 and 24-26 are now present in this application. Claims 1 and 8 are amended. No new matter is involved.

Reconsideration of the Application, as amended, is respectfully requested.

II. Rejection Under 35 U.S.C. §112, 2nd Paragraph

Claims 1-3, 5, 7-12, 21, 22 and 24-26 stand rejected under 35 U.S.C. §112, 2nd Paragraph. This rejection is respectfully traversed.

Claim 1 has been amended so that the terms “hydraulic device” and “body portion” are consistent throughout the claim, and the language “door on the dumpster” has been changed to --door-- to overcome the rejection.

Claim 8 has been amended to maintain consistent use of the term “hydraulic system.”

Applicants respectfully submit that the amendments to claims 1 and 8 obviate the grounds of rejection.

Reconsideration and withdrawal of this rejection are respectfully requested.

III. Rejections Under 35 U.S.C. §102

Claims 1-3, 6, 7 and 21 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,359,942 to Ward. This rejection is respectfully traversed.

A prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see, In re Paulsen, 30 F.3d 1475, 1478, 1479, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994), In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990), Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

Initially, Applicants respectfully note that claims 4 and 6 are canceled.

Claim 1 has been amended to positively recite a combination of features including a hydraulic device that is sized and constructed to be conventionally used while being remotely operated while being suspended from a crane, comprising a body portion that is sized and constructed to be conventionally used while being operated while being suspended from the crane.

Ward does not disclose these positively recited features, which are supported by Applicants' disclosure, which discloses that Applicants' remotely operated hydraulic device is conventionally used while being suspended from a crane.

The Office Action states that Ward's device contains all the structural elements as recited in claim 1 and the device is capable of being suspended from a crane to be moved to another location or to be repaired.

However, this is irrelevant to the claimed invention, which is clearly disclosed and claimed as being sized and constructed to be remotely operated in conventional use while being suspended from a crane.

In this regard, Applicants refer to the decision by the Court of Customs and Patent Appeals in In re Venezia, 189 USQ 149 (CCPA 1976).

In that case, a number of claims were presented. Claim 31 with emphasis, was representative of the claims on appeal and read, as follows:

31. A splice connector kit having component parts *capable of being assembled* in the field at the terminus of high voltage shielded electrical cables for providing a splice connection between first and second such cables, said cables each having a conductor surrounded by an insulating jacket within a conductive shield wherein a portion of the conductive shield is removed to expose the insulating jacket and a portion of the insulating jacket is removed to expose the conductor at the terminus of the cable, the kit comprising the combination of:

a pair of sleeves of elastomeric material, each sleeve of said pair *adapted to be fitted* over the insulating jacket of one of said cables, each said sleeve having an external surface and a resiliently dilatable internal bore for gripping the insulating jacket to increase the dielectric strength of the creep path along the insulating jacket;

electrical contact means *adapted to be affixed* to the terminus of each exposed conductor for joining the conductors and making an electrical connection therebetween;

a pair of retaining members *adapted to be positioned* respectively between each of said sleeves fitted over the insulating jacket of each said cable and the corresponding terminus of each said cable, said retaining members each having means cooperatively associated therewith for maintaining each said member's position relative to the insulating jacket on each said cable and for precluding axial movement of the sleeve toward the corresponding terminus of each said cable; and

a housing, said housing having an internal bore extending therethrough from end to end, said housing including portions adjacent each end thereof defining said internal bore and being resiliently dilatable *whereby said housing may be slideably positioned* over one of said cables and *then slideably repositioned* over said sleeves, said retaining members, and said contact means *when said sleeves, said retaining members and said contact means are assembled* on said cables as hereinaforesaid, said resiliently dilatable portions of said housing respectively gripping the corresponding external surface of each said sleeve in watertight sealing relationship therewith and said housing having a further portion intermediate its ends defining said internal bore and forming a sealed chamber enclosing at least said contact means and the exposed portions of said cable conductors *when said housing is in its repositioned location*.

The Court reviewed the disputed claims and in particular the language criticized by the Examiner and the Board, and concluded that the claims do define the metes and bounds of the claimed invention with a reasonable degree of precision and particularly, and that they are, therefore, definite as required by the second paragraph of Section 112. As the Court viewed these claims, they precisely define a group or "kit" of interrelated parts. The Court continued by stating:

These interrelated parts may or may not be later assembled to form a completed connector. But what may or may not happen in the future is *not* a part of the claimed invention. The claimed invention does include present structural limitations on each part, which structural limitations are defined by how the parts are to be interconnected in the final assembly, if assembled. However, this is not to say that there is anything futuristic or conditional in the "kit" of parts itself. For example, paragraph two of claim 31 calls for "a pair of sleeves * * * each sleeve of said pair *adapted to be fitted* over the insulating jacket of one of said cables." Rather than being a mere direction of activities to take place in the future, this language imparts a structural limitation to the sleeve. Each sleeve is so structured or dimensioned that it can be fitted over the insulating jacket of a cable. A similar situation exists with respect

to the "adapted to be affixed" and "adapted to be positioned" limitations in the third and fourth paragraphs of the claim. The last paragraph of claim 31 contains additional language criticized by the board, including "may be slideably positioned," "slideably repositioned," "when said sleeves * * * are assembled," and "when said housing is in its repositioned location." However, this language also defines present structures or attributes of the part of the "kit" identified as the housing, which limits the structure of the housing to those configurations which allow for the completed connector assembly desired. Again, a present structural configuration for the housing is defined in accordance with how the housing interrelates with the other structures in the completed assembly. We see nothing wrong in defining the structures of the components of the completed connector assembly in terms of the interrelationship of the components, or the attributes they must possess, in the completed assembly. More particularly, we find nothing indefinite in these claims. One skilled in the art would have no difficulty determining whether or not a particular collection of components infringed the collection of interrelated components defined by these claims. In re Miller, *supra*.

Applicants respectfully submit that claim 1, by reciting "A hydraulic device that is sized and constructed to be conventionally used while being remotely operated while being suspended from a crane," and by reciting "a body portion that is sized and constructed to be conventionally used while being operated while being suspended from the crane," and "a transmitter for remotely transmitting the control signal to the receiver to operate the pump when the hydraulic device is suspended from the crane," is positively reciting present structures or attributes of the identified hydraulic device, which limits the structure of the hydraulic device to sizes and constructions which allow for the hydraulic device to be conventionally used while being operated while being suspended from the crane.

Ward has no disclosure of a crane, and the statement in the rejection that "the device is capable of being suspended from a crane to be moved to another location or to be repaired" is speculation and is not disclosed expressly or inherently (necessarily) in Ward. In fact, the only disclosure of operation of Ward's hopper car is on the rails on which it is located in Fig. 1.

Accordingly, Ward does not anticipate claim 1.

Moreover, under the doctrine of inherency, if an element is not expressly disclosed in a prior art reference, the reference will still be deemed to anticipate a subsequent claim if the missing element "is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Cont'l Can. Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). "Inherent anticipation requires that the missing descriptive material is 'necessarily present,' not merely probably or possibly present, in the prior art." Trintec Indus., Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002) (quoting In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)).

Ward's railroad hopper car has absolutely no disclosure that it is designed to operate conventionally while suspended from a crane. As noted above, Ward's Fig. 1 only shows that Ward's railroad hopper car operates on railroad tracks.

Accordingly, Applicants respectfully submit that the combination of elements as set forth in independent claim 1 is neither disclosed nor suggested by Ward.

Similar comments apply to the features recited in claim 8, which positively recites a combination of features including a hydraulic system that is sized and constructed to be conventionally used while being remotely operated while being suspended from a crane, comprising a body portion that is sized and constructed to be conventionally used while being operated while being suspended from the crane.

That Ward's device is capable of being suspended from a crane to be moved to another location or to be repaired is irrelevant to the claimed invention, which is clearly disclosed and claimed as being sized and constructed to be remotely operated in conventional use while being suspended from a crane.

Moreover, because dependent claims 2, 3, 7, 9-12, 21, 22 and 24-26 depend from either claim 1 or claim 8 and contain all of the features of claim 1 or claim 8, dependent claims 2, 3, 7, 9-12, 21, 22 and 24-26 are not anticipated by Ward.

Reconsideration and withdrawal of this rejection are respectfully requested.

Claims 5 and 11 stand rejected under 35 USC §103(a) as unpatentable over Ward in view of anticipated by U.S. Patent Re. 36,685 to Bounds. This rejection is respectfully traversed.

Claim 1, from which claim 5 depends, and claim 8, from which claim 11 depends, are not anticipated by Ward for reasons stated above. Moreover, Bounds is not applied to remedy the aforementioned deficiencies in Ward.

Accordingly, even if it were obvious to modify Ward in view of Bounds, as suggested, the Office Action has not made a *prima facie* case that the resulting modified version of Ward would either anticipate or render obvious the claimed invention recited in claim 5 or claim 8, and this rejection should be withdrawn.

Claims 1-3, 5, 7-12, 21, 22 and 24-26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the prior art in view of U.S. Patent 3,858,728 to Fathauer, with reference being made to paper No. 5. This rejection is respectfully traversed.

The rejection is inherently unclear and fails to provide Applicants with a clear statement of the grounds of rejection, including a failure to identify the prior art on which this rejection is made.

Firstly, Applicants do not know what paper No. 5 is. Applicant does not have access to a file wrapper that shows what paper No. 5 is and none of the papers received from the USPTO include a paper number.

Secondly, the Office Action does not clearly identify what constitutes the asserted “prior art,” leaving Applicants to guess at what constitutes this unidentified prior art.

Thirdly, the previous Office Action on the merits, dated March 8, 2005, makes a number of rejections on various references, including Ward, Hale et al., Bounds, Prescott et al., Fathauer and Liegel et al. It is not clear which of these references the rejection is relying on as prior art to be used in conjunction with Fathauer.

Fourthly, the body of this rejection only discusses Fathauer and does not explain how the unidentified “prior art” is to be modified in view of Fathauer.

Fifthly, no objective factual evidence is presented to explain why one of ordinary skill in the art would want to motivate the unidentified prior art in view of Fathauer.

Sixthly, Fathauer only has a single remotely operated control switch located on its spreader to operate the spreader. Claims 1-3, 5, 7-12, 21, 22 and 24-26 recite a combination of features including a manually operated switch located at the device (claims 1-3, 5, 7 and 21) or the hydraulic system (claims 8-12, 22 and 24-26) suspended from the crane.

Fathauer does not disclose or suggest such a feature. Nor does the Office Action even address this positively recited feature. Nor does the Office Action provide a proposed motivation, or objective evidence in support thereof,

for one of ordinary skill in the art to modify prior art in view of Fathauer, or *vice versa*, to provide such a positively recited feature.

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the claimed invention.

Accordingly, this rejection of claims 1-3, 5-12, 21, 22 and 24-26 is improper and should be withdrawn.

VI. Conclusion

All of the stated grounds of rejection have been rendered moot. Applicants therefore respectfully request that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

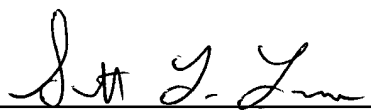
If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to *telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8076, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By:  #41,458
James T. Eller, Jr., #39,538

JTE/RJW:gf

P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000